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| 09/938,144      | 08/23/2001  | Robert Barry Wood    | STL9833/40046.150USU1 | 1721             |

7590 08/18/2005

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| EXAMINER |
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KNAPP, JUSTIN R

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| ART UNIT | PAPER NUMBER |
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2182

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/938,144

Applicant(s)

WOOD, ROBERT BARRY

Examiner

Justin Knapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 13-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 13-17, and new claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker, MP3: The Definitive Guide, published March 2000 in view of the IEEE 100, The Authoritative Dictionary of IEEE Standards Terms, 7<sup>th</sup> Ed, (c) 2000 (hereby referred to as IEEE).

As per claims 1-6, 13-17 and new claims 18-23, Hacker teaches an MP3 player that makes use of IBM's MicroDrive (see figure on page 4 of 10 as well as section 6.2.1.2 starting on page 3 of 10). The use of the MicroDrive in an MP3 player reads on the claimed limitations: "a data disc rotatably mounted on a baseplate", "an actuator arm adjacent to the data disc carrying a transducer for reading data from and writing data to the data disc", and "a PCB fastened to the baseplate having a servo controller in operable communication with the actuator arm for moving the actuator arm over the data disc" as these are essential components to any MicroDrive as it nothing more than a miniature hard drive able to store data on it's magnetic data disc. Without these claimed components, data could not be written or read to/from the MicroDrive. As further proof that hard drives are utilized in an MP3 player, Hacker teaches on page 2 of 10, section 6.2.1, that just prior to press time [of this reference] a new player called Personal Jukebox has announced an MP3 player packing a 4.86 GB hard drive capable of storing around 100 CDs

worth of music in a form factor only slightly larger than a traditional MP3 portable. A hard drive containing room for 4.86 GB of data means a portable hard drive with moving parts (servo controller, actuator arm, etc) is utilized.

A “CPU generating control signals to the servo controller and running an operating system” is an inherent feature for an MP3 player to function properly. Without a processor, instructions cannot be processed. Without instruction processing, the MP3 player would not work. Printed circuit board is well known in the art for providing connections to various components to allow for communication between components as well as also provide a foundation in which components are commonly mounted and secured in an electronic device.

Hacker further teaches a “memory storing an application program operably connected to the CPU, whereby the application program is run by the CPU”. Table 6.1 on page 9 of 10 shows MP3 players have several programs installed including audible codecs essential to playing an MP3 file as well as EQ controls program to adjust various EQ settings such as bass and treble. These programs are stored in a memory of the MP3 player.

Hacker also teaches an MP3 player that is within a 3 ½ inch form factor as seen on Table 6.1. Table 6.1 also teaches an MP3 player whose components are contained within a case.

Hacker teaches an MP3 player connected to a communication network comprising an input/output module communicating to a node connected to the communications network or LAN. A network by definition is an arrangement of components or nodes and interconnecting branches. Therefore, Hacker teaches an MP3 player with parallel and USB modules used to connect to a computer for the transfer of data files as seen on page 1 of 10. This interconnection

establishes a local network between the MP3 player and another computer in which it is communicating with.

On page 5 of 10, Hacker teaches the utilization of a HTTP protocol to gather information from a website based on information on an MP3 player.

The figure on page 5 of 10 shows an MP3 player with a display. The display indicates that a video interface module must exist on the MP3 player in order to display information on the display. It would have been obvious and is also a well known feature of several MP3 players that upon connecting an MP3 player to a computer via an USB/parallel connection, the connection establishing a network would drive the video display module to indicate on the display that a connection has been made.

IEEE defines an operating system as a collection of software, firmware, and hardware elements that controls the execution of computer programs and provides such services as computer resource allocation, job control, input/output control, and file management in a computer system. Utilizing this definition, it would be obvious to one of ordinary skill in the art at the time the invention was made that an MP3 player taught by Hacker must contain an operating system. Hacker teaches an MP3 player that is software upgradeable. This means new programs can be installed on the system. An OS is necessary for this functionality. Furthermore, an OS is necessary to act as a file manager for the MP3 and other data files stored on an MP3 player. Taking these factors into account, it is evident an OS is used.

Utilizing the teachings of Hacker in view of IEEE, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create a data storage device with

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the claimed limitations as the claimed limitations are essential to the functionality of MP3 players taught be Hacker in view of IEEE.

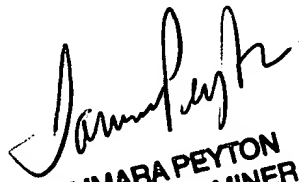
### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (571) 272-4149. The examiner can normally be reached on Mon - Fri 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 5, 2005

  
**TAMMARA PEYTON**  
**PRIMARY EXAMINER**

Justin Knapp  
Examiner  
Art Unit 2182